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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,259	12/12/2003	Jean Cotteret	LORE:014US	9789

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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,259

Applicant(s)

COTTERET ET AL.

Examiner

Eisa B. Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,11,22-29,32-39 and 42-64 is/are rejected.
- 7) ☒ Claim(s) 9,12-21, 30-31 and 40-41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1 This action is responsive to the amendment filed on May 20, 2005.

2 The cancellation of claim 2 is acknowledged. Pending claims are 1 and 3-64.

3 Claims 1, 3-8, 10-11, 22-26, 48-53, 55-61 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Lim et al. (US 6,461,391 B1) for the reasons set forth in the previous office action mailed on 11/17/2004.

4 Claims 54 and 62-63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) for the reasons set forth in the previous office action mailed on 11/17/2004.

5 Claims 27-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Vidal et al. (FR'696/US' 225 A1) for the reasons set forth in the previous office action mailed on 11/17/2004.

6 Claims 32-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Vidal et al. (FR'696/US' 225 A1) and further in view of Mockli (US' 151) for the reasons set forth in the previous office action mailed on 11/17/2004.

7 Claim 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Vidal et al. (FR'696/US' 225 A1) and further in view of Vidal et al. (FR' 696/US' 676 A1) for the reasons set forth in the previous office action mailed on 11/17/2004.

8 Claim 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Vidal et al. (FR'696/US' 225 A1) and further in view of Vidal et al. (WO' 659/US' 675) for the reasons set forth in the previous office action mailed on 11/17/2004.

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9 Claim 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Vidal et al. (FR'696/US' 225 A1) and further in view of Vidal et al. (WO' 658 A1/US' 263 A1) for the reasons set forth in the previous office action mailed on 11/17/2004.

10 Claim 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 6,461,391 B1) in view of Vidal et al. (FR'696/US' 225 A1) and further in view of Vidal et al. (WO' 657 A1/US' 400 A1) for the reasons set forth in the previous office action mailed on 11/17/2004.

11 Claims 42-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US' 391 B1) in view of Vidal et al. (FR' 696/US' 225) and further in view of Rondeau et al. (US' 146 B1) for the reasons set forth in the previous office action mailed on 11/17/2004.

12 Claim 47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US' 391 B1) in view of Kawai et al. (US 2002/0244356 A1) for the reasons set forth in the previous office action mailed on 11/17/2004.

13 The rejection of claims 34-35 and 40-41 under 35 U.S.C. 103(a) over the prior art of records is withdrawn based on the applicant's remarks.

14 Claims 9, 12-21, 31, 34-35 and 40-41 objected to as being dependent upon rejected base claims.

Response to Applicant's Arguments

Applicant's arguments filed on 5/20/2005 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1, 3-8, 10-11, 22-26, 48-53, 55-61 and 64 under

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35 U.S.C. 102(b) over Lim et al. (US' 391 B1), Applicant argues that Lim et al. (US' 391 B1) disclose inherently only the cationic nature of the dyes due to the lack of any express disclosure in regard to identification or structure of the required element as claimed.

The examiner respectfully disagrees with the above argument because a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegeaal Bros. v. Union Oil Co. of California*, 824 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claims is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). In this case Lim et al. (US' 391 B1) teaches a composition comprising an oxidation base of cationic tertiary para-phenylenediamine having a formula (1), which is identical to the claimed formula (I) (see col. 2, formula (1) and lines 44-50) and Basic blue 17 dye as a cationic direct dye comprising heterocyclic group (see col. 7, line 53). The examiner in his response to the applicant's arguments provided the structure of the cationic heterocyclic dye Basic blue 17 in the attached document (see R.D. Lillie, Aldrich chemical catalogue, 1992). Therefore, Lim et al. (US' 391 B1) teaches an oxidation base of cationic tertiary para-phenylenediamine and at least one cationic direct dye comprising at least one heterocyclic group as claimed. Hence, the anticipation rejection is proper and maintained.

With respect to the rejection of claims 54 and 62-63 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1), Applicant argues that nothing in Lim et al. (US' 391 B1) suggests the desirability of the particular combination of a direct dyes with at least one heterocyclic group and

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a cationic oxidant base as required by the present invention. Applicant also argues that there is no motivation to use the multi-compartment container as claimed.

The examiner respectfully disagrees with the above arguments because; a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); *In re Fracalossi*, 681 F. 2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lamberti*, 545 F. 2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Boe*, 355 F. 2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). In this case *Lim et al.* (US' 391 B1) teaches a composition comprising an oxidation base of cationic tertiary para-phenylenediamine and cationic direct dye comprising at least one heterocyclic (Basic blue 17) among other direct dyes to be used in the dyeing composition. Further, *Lim et al.* (US' 391 B1) clearly teaches that the oxidation composition is mixed with the oxidizing agent at the time of use, which implies that both oxidation composition and oxidizing agents are provided in a separate containers (see col. 9, lines 60-63). Therefore, and based on the teaching of the reference, there is a sufficient motivation to one having ordinary skill in the art to formulate a dyeing composition that comprises an oxidation base of cationic tertiary para-phenylenediamine and at least one cationic direct dye comprising at least one heterocyclic (Basic blue 17) among other direct dyes to be used in the dyeing composition and to separate the dyeing ingredients from the oxidizing agents using suitable containers for holding the dyeing composition. Therefore, the rejection is proper and the prima facie case of obviousness has been established.

With respect to the rejection of claims 27-29 under 35 U.S.C. 103(a) over *Lim et al.* (US' 391 B1) in view of *Vidal et al.* (FR 2822 696/US 2004/0187225), Applicant argues that there is

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no motivation to combine the references.

The examiner respectfully disagrees with the above argument because Lim et al. (US' 391 B1) as a primary examiner suggests the use of at least one direct dye in the dyeing composition and the direct dye Basic blue 17 as a cationic dye comprising heterocyclic group is among these dyes (see col. 7, lines 53). Vidal et al. (FR'696/US'225) as a secondary reference clearly teaches the cationic direct dyes of the claimed formula (Va) (see page 2, paragraph, 0015-0030). It is further taught by Vidal et al. (FR'696/US'225) that the use of cationic diazo dyes in the dyeing composition would provided a very broad range of colors, in particular highly chromatic colors, without forgetting the basic shades such as the blacks and the browns (see page 1, paragraph, 0013). Therefore, there is a sufficient motivation to one having ordinary skill in the art to be motivated to incorporate the cationic direct dyes as taught by Vidal et al. (FR'696/US'225) in the composition of Lim et al. (US' 391 B1) with a reasonable expectation of success for improving the performance of the dyeing composition. Therefore, the rejection under 103 (a) is proper and maintained.

With respect to the rejection of claims 32-33 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Vidal et al. (FR 2822 696/US 2004/0187225) and further in view of Mockli (US 5,708, 151), Applicant argues that there is no motivation to combine the references. Applicant also argues that the statement "provide hair with shades having goon fastness properties" is made in reference (US' 151) to the intermediates represented by compounds of formula (8) and not made in regard to dicationic dyes that have the limitations of the dicationic dyes of formula (Vc) or (Vd) as claimed. Applicant further argues that the reference teaches away from using these compounds for hair.

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The examiner respectfully disagrees with the above arguments because Lim et al. (US' 391 B1) as a primary examiner suggests the use of at least one direct dye in the dyeing composition and the direct dye Basic blue 17 as a cationic dye comprising heterocyclic group is among these dyes (see col. 7, lines 53). Vidal et al. FR'696/US'225) as a secondary reference clearly teaches the cationic direct dyes of the claimed formula (Va) (see page 2, paragraph, 0015-0030). Mockli (US' 151) as a secondary reference also teaches a composition comprising cationic dyes of the claimed formulae (Vc) and (Vd) (see col. 13 and 14 the upper formula) and wherein formula (8) is part of the general formula (1) that represented by the specific formula that taught by Mockli (US' 151) in cols. 13 and 14. It is further taught by Mockli (US' 151) that the compounds of the intermediate formula (8) are used for dyeing materials that are commonly dyed with cationic dyes to obtain a dyeing in red or violet shades with good fastness properties when applied to the materials such as hair and specially living human hair (see col. 6, lines 43-49). Therefore, there is a sufficient motivation to one having ordinary skill in the art to be motivated to incorporate the cationic direct dyes as taught by Mockli (US' 151) in the composition of Lim et al. (US' 391 B1) with a reasonable expectation of success for improving the performance of the dyeing composition. Therefore, the rejection under 103 (a) is proper and maintained.

With respect to the rejection of claim 36 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Vidal et al. (FR' 696/US' 225) and further in view of Vidal et al. (FR'698/US'676 A1), Applicant argues that there is no motivation to combine the references.

The examiner respectfully disagrees with the above arguments for the same reasons as mentioned above.

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With respect to the rejection of claim 37 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Vidal et al. (FR' 696/US' 225) and further in view of Vidal et al. (WO' 659 A1/US' 675 A1), Applicant argues that there is no motivation to combine the references.

The examiner respectfully disagrees with the above arguments for the same reasons as mentioned above.

With respect to the rejection of claim 38 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Vidal et al. (FR' 696/US' 225) and further in view of Vidal et al. (WO' 658 A1/US' 263 A1), Applicant argues that there is no motivation to combine the references.

The examiner respectfully disagrees with the above arguments for the same reasons as mentioned above.

With respect to the rejection of claim 39 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Vidal et al. (FR' 696/US' 225) and further in view of Vidal et al. (WO' 657 A1/US' 400 A1), Applicant argues that there is no motivation to combine the references.

The examiner respectfully disagrees with the above arguments for the same reasons as mentioned above.

With respect to the rejection of claims 42-46 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Vidal et al. (FR' 696/US' 225) and further in view of Rondeau et al. (US' 146 B1), Applicant argues that there is no motivation to combine the references.

The examiner respectfully disagrees with the above arguments for the same reasons as mentioned above.

With respect to the rejection of claim 47 under 35 U.S.C. 103(a) over Lim et al. (US' 391 B1) in view of Kawai et al. US' 356 A1), Applicant argues that there is no motivation to

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combine the references.

The examiner respectfully disagrees with the above arguments for the same reasons as mentioned above.

15 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

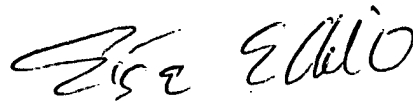
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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A handwritten signature in black ink, appearing to read 'Eisa Elhilo', is positioned above the printed name.

Eisa Elhilo
Patent Examiner
Art Unit 1751

July 31, 2005